

09-17-04

10/17/04



Bayer 10,019.2-Reissue
100717-600
Le A 31 192 Lu/Ho US-Reissue

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Klaus-Helmut Müller et al.
SERIAL NO. : 10/603,997
FILED : 25 June 2003 (date granted 5 November 2003)
FOR : HERBICIDAL SULPHONYLAMINO(THIO)CARBONYL COMPOUNDS
ART UNIT : 1625
EXAMINER : Patricia Morris

16 September 2004

Mail Stop: Petitions

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR § 1.17(h) - INCORRECT FILING DATE ASSIGNED

SIR:

In response to the USPTO's dismissal (mailed on 16 July 2004) of the applicants' previous petition under 37 CFR §1.17(h) dated 5 April 2004, please accept this new petition under 37 CFR § 1.17(h) which further explains and offers evidence of the applicants contention that the originally filed items including the specification and claims were in fact deposited with the USPTO and that the applicants should be accorded a filing date of 25 June 2003.

As stated in the petition dismissal of 16 July 2004: "An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence." (i.e. "is more likely than not to have been misplaced"). The applicants present that based on the evidence presented herewith, it is more likely than not that the applicants complied with the filing requirements which entitle them to a filing date of 25 June 2003 and that any missing papers were the result of inadvertent misplacement or loss of papers by the USPTO.

Specifically, applicants submit that they filed a complete application for broadened reissue of U.S. Patent No. 6,251,831 on June 25, 2003. Applicants further submit that such submission included a complete copy of the specification and claims of U.S. Patent No. 6,251,831 in double column patent

format.

In support of this position, applicants offer the following:

- (1) As indicated by Ms. Nanci Manfredi in her declaration under 37 CFR 1.132 (hereafter referred to as the "declaration"), the primary means for Norris, McLaughlin & Marcus, P.A. (hereafter referred to as the "firm") to determine safe receipt of all items filed with the USPTO is receipt of the stamped return receipt postcard. (See Manfredi Declaration at numbered paragraph 3.) Ms. Manfredi attests in her declaration that this postcard was received by the firm and that there was no indication that the specification and claims was missing. (See Manfredi Declaration at numbered paragraph 8.) Quite the contrary, the return receipt postcard is stamped, thereby confirming receipt of a specification and claim.
- (2) All of the items listed on the applicants' Express Mail Certificate (Exhibit A) and return receipt postcard (Exhibit B) were sent via Express Mail (Label No. EV 191672616) by Vilma Fernandez. (A separate declaration from Ms. Fernandez could not be obtained as she no longer works for the firm. However, Ms. Manfredi attests in her declaration that it is standard procedure for the firm to itemize each item sent to the USPTO on an Express Mail Certificate and/or return receipt postcard (See Manfredi Declaration at numbered paragraph 3.))
- (3) Ms. Manfredi also attested in her declaration that she recorded that the mailing date of the reissue application, which included the specification, claims and abstract, was 25 June 2003 and entered this information into Norris, McLaughlin's patent database. (See Manfredi Declaration at numbered paragraph 12.)
- (4) In addition to direct evidence of receipt by the USPTO of the applicants specification, claims and abstract on 25 June 2003, the applicants also provide secondary evidence to show that it was more likely than not that the USPTO received the entire specification, claims and abstract as part of the applicants' mailing dated 25 June 2003.

A copy of the applicants' Reissue Patent Application Transmittal sheet as it appears in Private PAIR shows that this paper was assigned a date of 25 June 2003 but indicated on the margin that no specification or claims had been received (see Exhibit C). ***However, this is incongruous not***

only with the stamped return receipt postcard but also with the mailing charges for the applicants' Express Mail filing of the reissue application papers.

The applicants' receipt for this Express Mail from the U.S. Postal Service (Exhibit D) indicated a **total mailing cost of \$27.30** which is reflective of the cost of mailing all of the items cited on the Express Mail Certificate (Exhibit A) which would include a complete copy of the specification, claims and abstract from U.S. Patent 6,251,831 (a 207 page patent).

If the USPTO's position was correct that no specification or claims were actually mailed by the applicants, the cost of mailing via Express Mail for all of the items listed on the Express Mail Certificate ***except for*** the specification, claims and abstract would only have **a mailing cost of about \$13.65.**

Further on this point, applicants believe the express mail charge was at that time a function of weight, and, in any event, the express mail receipt indicates that the weight of the submission mailed to the USPTO on 25 June 2003 was 4 lbs., 3.10 oz. As Ms. Manfredi attests in her declaration, this is ***consistent*** with a package that included the weighty 207 page specification and claims of U.S. Patent No. 6,251,831, and inconsistent with a package that did not include the specification and claims of U.S. Patent No. 6,251,831. (See Manfredi Declaration at numbered paragraph 11.) Reconstructing the packages that, respectively, applicants and the USPTO believe were sent, Ms. Manfredi found that "applicants" reconstructed package containing the specification and claims of U.S. Patent No. 6,251,831 weighed 4 lbs., 2.80 oz., in close agreement with the weight on the express mail receipt, whereas the "USPTO's" reconstructed package devoid of the specification and claims of U.S. Patent No. 6,251,831 weighed only 2 lbs., 1.80 oz., which was in substantial disagreement with the weight on the express mail receipt. (See Manfredi Declaration at numbered paragraph 11.) This strongly supports applicants' position that the original submission mailed to the USPTO on 25 June 2003 contained the entire specification and claims of U.S. Patent No. 6,251,831.

(5) The USPTO's position is that the applicants' 25 June 2003 filing did not include a copy of the specification and claims, i.e. none of the 207 pages which constitutes U.S. Patent 6,251,831 was sent by the applicants and by inference, that the USPTO did not lose or misplace the specification or claims if it had been filed by the applicants. However, the only evidence in support of this

position is the written statement on the Private PAIR version of the applicants Reissue Patent Application transmittal sheet (see Exhibit C). This evidence in support of the USPTO's position is outweighed by the collective evidence represented by the return receipt postcard and the Manfredi Declaration.

(6) The applicants submit that Ms. Fernandez followed the firm's standard operating procedures for filing a new application which includes filing a copy of the specification, claims and abstract for the reissue application and that this was verified by Ms. Manfredi. Moreover, the substantial difference in the expected (for a missing specification and claims) vs. the actual postage charge and weight for the 25 June 2003 filing clearly show that something was mailed in excess of the papers acknowledged as being received by the USPTO.

The USPTO's position cannot account for such a discrepancy in postal charges and weight; the applicants' accrued postal charge and weight are more in keeping with the filing of the 207 page specification, claims and abstract for U.S. Patent 6,251,831 than for not filing these items.

Therefore, when balancing the USPTO's evidence of non-receipt of the specification and claims vs. the applicants' evidence supporting that the specification and claims were filed, the applicants believe that it would appear more likely than not to an impartial observer that the specification and claims were filed on 25 June 2003 and as such, this is the filing date which should be accorded to the applicants.

It is believed that the USPTO has a complete copy of the specification and claims of U.S. Patent No. 6,251,831 on file. However, if not, the examiner is respectfully requested to telephone the undersigned at telephone number 212-808-0700 so that any missing pages can be supplied immediately.

NOTE: Since this reissue application is a broadening reissue, the requested filing date is critical for the applicants as all broadening reissues must be filed within two years of the grant date of the patent (26 June 2003 was the deadline date for filing this application).

Because of the criticality of the requested filing date, before a decision on this petition is reached, the applicants' would like to schedule a personal interview with the Petitions Attorney assigned to this application so that any questions about the circumstance of this filing can be resolved favorably. Please contact the undersigned if the applicants have

been unable to establish contact with the Office of Petitions to set an interview date.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the petition above requires an extension of time, Applicants respectfully request that this be considered a petition therefore. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Closing

Applicants also believe that this petition address the refusal of the inventor to sign the combined power of attorney/oath and declaration. The original combined power of attorney/oath and declaration is sufficient in view of the fact that the original submission mailed on 25 June 2003 was complete and included the specification and claims of U.S. Patent No. 6,251,831. However, should any issue(s) of a minor nature remain, the USPTO is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

Attachments: Courtesy copies of:

- (1) Cover page of U.S. Patent 6,251,831
- (2) Page (co.) 407-408 of U.S. Patent 6,251,831

Declaration under 37 CFR 1.132 (by Nanci Manfredi)
Exhibit A - Express Mail Certificate
Exhibit B - Return Receipt Postcard
Exhibit C - Reissue Patent Application Transmittal (Private PAIR version)
Exhibit D - Express Mail receipt (for Express label 191672616)
Exhibit E - Index card for SN: 10/603,997
Exhibit F - Database entry for SN: 10/603,997

CERTIFICATE OF EXPRESS MAILING

I hereby certify that the foregoing Petition Under 37 CFR 1.17(h) is being deposited with the United States Postal Service as Express Mail, Label No. EV 424018656 US in an envelope addressed to: Hon. Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below:

Date: 16 September 2004

By: Agata Glinska
Agata Glinska



Bayer.10.019.2.REI

HERBICIDAL SULPHONYLAMINO(THIO) CARBONYL COMPOUNDS

EXPRESS MAIL CERTIFICATE

Express Mail Label No. EV 191672616 US

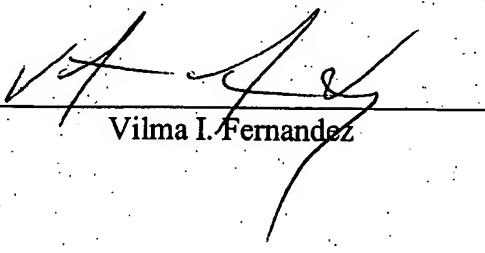
Date of Deposit: 25 June 2003

I hereby certify that the following items:

1. Reissue Patent Application Transmittal
2. Fee Transmittal (in duplicate)
3. Preliminary Amendment
4. unexecuted Reissue Oath/Declaration/Power of Attorney
5. Specification and Claims in double column copy of patent format
6. Information Disclosure Statement and Form PTO-1449 (attaching and citing one (1) reference)
8. Application Data Sheet
9. return receipt postcard
10. copies of Recordation Cover Sheet and Assignment

are being deposited with the United States Postal Services Express Mail Post Office to Addressee service under 37 CFR 1.10 on the date indicated above and is addressed to the Hon. Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Mail Stop Reissue.

NORRIS, McLAUGHLIN & MARCUS, P.A.

By 

Vilma I. Fernandez

EXHIBIT A

(SN: 10/603,997)



BAYER
CASE # 10,019.2 REI

DATE MAILED: 25 June 2003

The stamp of the Patent Office hereon may be taken as acknowledgement of receipt, on the date stamped, of the following:

1. Reissue Patent Application Transmittal
2. Fee Transmittal (in duplicate)
3. Specification and Claims in double column copy of patent format
4. Reissue Oath/Declaration (unexecuted)
5. Information Disclosure Statement and Form PTO-1449 citing and attaching reference
6. Application Data Sheet
7. Preliminary Amendment
8. copies of Recordation Cover Sheet and Assignment
9. Express Mail Certificate

EV 191672616 US

06/25/03
10/603997
17302

Serial No. Reissue of
6,251,839

DATE DUE:

TEST AVAILABLE COPY

EXHIBIT B

(SN: 10/603, 997)



Pair : Dossier Image Location - Microsoft Internet Explorer

File Edit View Favorites Tools Help

Address http://pair-direct.uspto.gov/final/images/pair_efw_image_loc(frames).htm

Page 0

Transmittal Reissue Application : 4 Page(s).

1 Go

Return to Document List

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05/27/04

Patent Application Information Retrieval

Approved for use under DODIG-02-002, 02-05-2002

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Freedom of Information Act of 1966, no patents are required to respond to a request for information unless it disclosure a valid trade secret or other

REISSUE PATENT APPLICATION TRANSMITTAL

Attorney Docket No. 10-010-27-97

First Related Examiner MILLER, S. M.

Original Patent Number 1,251,011

Original Patent Issue Date 26 June, 2001

Express Mail Label No. 1016527614-00

Address to:

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR REISSUE OF: Utility Patent Design Patent Plant Patent

APPLICATION ELEMENTS (37 CFR 1.173)

- Fee Transmitted Form (PTO/SB/02) (where required and for electronic filing only)
- Application status small entity status. See 37 CFR 1.27.
- Specification and Claims in double column copy of patent (or amendment, if appropriate)
- Drawing(s) (proposed amendment, if appropriate)
- Patent Office Declaration (original or copy) 37 CFR 8.1.173 (PTO/SB/07) or 82
- Power of Attorney
- Original U.S. Patent, clearly marked Yes No (if Yes, check applicable box(es))
 - Written Consent of all Assignees (PTO/SB/53)
 - 37 CFR 8.3.7(b) Statement (PTO/SB/56)
 - CD-ROM or CD-R in duplicate, Computer Program (Appendix or large table)
 - Notarized under Article 4 of the Hague Convention (if applicable) or a Notary Public, all of the Assignees are deceased
 - Computer Readable Form (CRF)
 - Specification Sequence Listing or CD-ROM (2 copies) or CD-R (2 copies); or
 - paper
 - statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

- Statement of status and support for all changes to the claims. See 37 CFR 1.173 (c).
- Original U.S. Patent or commander
- Written Original Patent Grant
- Statement of Loss (PTO/SB/50)
- Foreign Priority Claim (37 U.S.C. 118) (if applicable)
- Information Disclosure Statement (IDS) (PTO/SB/146) Copies of IDS
- English Translation of Patent Specifications (if applicable)
- Preliminary Amendment
- Return Receipt Postcard (RCP) (37 CFR 1.16) (Should be specifically justified)
- Other _____

18. CORRESPONDENCE ADDRESS

Customer Number or Bar Code Label 27341 Correspondence address below

Address _____

City _____ State _____ Zip Code _____

Country _____ Telephone _____

NAME - Primary: ROBERT C. LEE Preparation by: Primary: 48-106
Signature: *Robert C. Lee* Date: 23 June 2003

Remarks: This form is submitted to take O.S. action to complete. ITW is very departing upon the results of the individual case. Any documents or correspondence sent to this address should be addressed to: U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Done

Start > UPATED PHONE L... Pairs under 37 CFR 1250 Microsoft Internet Explorer 12:59 PM

EXHIBIT C

BEST AVAILABLE COPY

(10/603, 997)



CROP

00717 027 (600)

LN 9703

BAYER 10019.2 RE1-HCL SN 10/603,997 FILED 6/25/03

Reissue appl Prelim, Info provided - 6-25-03 (REISSUE OF 6,251,831)
CUL: 12/25/03 LEA 31/192

Notice Income: 9-5-03

Spec. Appl Recd & Review Date Recd: 11-5-03

Reissue Recd Spec & Date Review: 11-5-03

Cul: 9-25-04

Correct Appl: 2-9-04

Abstract Recd: 4-9-04

Petition Recd: 4-9-04

Petition R1.17 w/copies placed: 4-5-04

CUL: 10-5-04

EXHIBIT E

(SN: 10/603,997)



Country Application

Wednesday, September 15, 2004

Page: 1

Case Number: 00717 027

Country: US

SubCase: I2

Client: Bayer AG

United States of America

Case Type: REI

Application Status: Pending

Application Number: 10/603997

Filing Date: 05-Nov-2003

Publication Number:

Publication Date:

Patent Number:

Issue Date:

Parent/PCT Number: EP96/02826

Parent/PCT Date : 28-Jun-1996

Parent Issue Number: 6251831

Parent Issue Date : 26-Jun-2001

Tax Schedule: LE

Expiration Date:

Confirmation #: 9703

Patent Term Adjustment: 0

Agent: NMM

Agent Reference #: NY

Norris McLaughlin & Marcus

Remarks: Bayer 10019.2 Rei

REISSUE APPL,PRELIM,INFO MLD-6/25/03

ON PETITION-7/16/04 DISMISSED

EXHIBIT F

(SN: 10/603, 997)



Bayer 10,019.2-Reissue
100717-600
Le A 31 192 Lu/Ho US-Reissue

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Klaus-Helmut Müller et al.
SERIAL NO. : 10/603,997
FILED : 25 June 2003 (date granted 5 November 2003)
FOR : HERBICIDAL SULPHONYLAMINO(THIO)CARBONYL COMPOUNDS
ART UNIT : 1625
EXAMINER : Patricia Morris

16 September 2004

Mail Stop: Petitions

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R 1.132

I, Nanci Manfredi, of 21 Keats Street, Staten Island, New York 10308, a citizen of the United States, hereby declare that:

1. I am the docket clerk for Norris, McLaughlin & Marcus, P.A. (hereinafter "Norris, McLaughlin") and have been employed in this capacity for Norris, McLaughlin and precursor firms for Norris, McLaughlin's patent practice for over 24 years.
2. I am responsible for reminding attorneys/agents at Norris, McLaughlin of USPTO filing deadlines and for keeping a record of papers filed with the USPTO by Norris, McLaughlin secretaries from the return receipt postcard and/or mailing certificate and for receipt of papers sent to Norris, McLaughlin by the USPTO.
3. I am aware of the circumstances surrounding the disagreement for the filing date of SN: 10/603,997 and attest that it is standard procedure within Norris, McLaughlin to list each item mailed to the USPTO on an Express Mail Certificate, when express mail is used, and a return receipt postcard and that our primary method of receiving an indication that all papers were

received by the USPTO is the receipt of the return receipt postcard.

4. According to the standard practice of Norris, McLaughlin, when a return receipt postcard is included with a submission to the USPTO, a copy of the return receipt postcard is made and kept in the file.
5. When such a return receipt postcard is returned to Norris, McLaughlin from the USPTO, the return receipt postcard is routed to me, and I make a note in our docketing system that the return receipt postcard has been received.
6. The records of Norris, McLaughlin indicate that an Express Mail Certificate, listing "Specification and Claims in double column copy of patent format," was included along with a submission of papers mailed to the USPTO on 25 June 2003 for SN: 10/603,997 (see Exhibit A).
7. The records of Norris, McLaughlin further indicate that a return receipt postcard, also listing "Specification and Claims in double column copy of patent format," was included along with a submission of papers mailed to the USPTO on 25 June 2003 for SN: 10/603,997 (see Exhibit B).
8. The return receipt postcard for the papers filed on 25 June 2003 for SN: 10/603,997 was stamped and mailed to Norris, McLaughlin, and there is no indication that the specification and claims were not received by the USPTO; MPEP 503 stipulates that any item not received is crossed out before mailing the return receipt postcard (see Exhibit B).
9. The submission to the USPTO on 25 June 2003 for SN: 10/603,997 was made by express mail, and the express mail receipt is attached (see Exhibit D).
10. I am aware that the USPTO denies receiving the specification and claims of U.S. Patent No. 6,251,831. However, this appears to be refuted by the stamped return receipt postcard.
11. As further evidence that the USPTO received the specification and claims of U.S. Patent No. 6,251,831, I have used as a reference the weight entry on the express mail receipt (Exhibit D), which was entered by an employee of the U.S. Postal Service. I reconstructed a package including all of the items listed on the return receipt postcard, i.e., including the specification and

claims, and the weight was substantially the same as that indicated on the express mail receipt. The weight of the package was 4 lbs., 2.80 oz., and the weight indicated on the express mail receipt was 4 lbs., 3.10 oz. In other words, the two weights were in substantial agreement. I also weighed a second package that included all of the items on the return receipt postcard with the exception of the specification and claims, and the weight of such package was only 2 lbs., 1.80 oz. As this is a substantial departure from the weight indicated on the express mail receipt, the only logical conclusion is that the specification and claims were, in fact, included as a part of the submission mailed to the USPTO on 25 June 2003. As the USPTO concedes that it received some of the papers in the submission mailed to the USPTO on 25 June 2003, and as all of the papers went together in a single envelope, it follows that the USPTO did, in fact, receive the specification and claims on 25 June 2003.

12. I further attest that I made the handwritten entries on the index card indicating that the reissue application (which included the specification, claims and abstract) had been mailed to the USPTO on 25 June 2003 (see Exhibit E) and that this information was subsequently recorded into our database system (CPI Patent Management System - see Exhibit F).
13. The undersigned declarant hereby declares that all statements made herein of his/her own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

9/16/04

Date

Nanet Manfredi

Ms. Nanet Manfredi
Docket Clerk
Norris, McLaughlin & Marcus, P.A.



Attorney Docket No. 100717-600/ Bayer 10,019.2 Rei

APPLICANT: Müller et al.

TITLE: Herbicidal Sulphonamino(thio) carbonyl compounds

USSN: 10/603,997

FILED: November 5, 2003

EXPRESS MAIL CERTIFICATE

"Express Mail" mailing label number EV 424018656 US

Date of Deposit September 16, 2004

I hereby certify that the following items:

1. Petition under 37 CR 1.17(h)- Incorrect Filing Date Assigned (6 pgs.)
2. Attachment: Exhibit A, B, C, D, E, F; Cover page and pgs. 407-408 of US Patent 6,251,831
3. Declaration under 37 CFR 1.132 (3 pgs.)
4. Express Mail Certificate
5. Return Receipt Postcard

are being deposited with the United States Postal Services "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313.

NORRIS, McLAUGHLIN & MARCUS, P.A.

By Agata Glinska
Agata Glinska